

REMARKS

Claims 1 – 9 are pending. The applicants respectfully request reconsideration and allowance of this application in view of the above amendments and the following remarks.

Claims 1, 6 and 7 were objected to for various informalities detailed in the office action. Claims 1, 3, 6 and 7 have been carefully reviewed and amended to clarify those instances identified in the office action.

Claims 1 – 9 were rejected under 35 USC 103(a) as being unpatentable over U.S. Patent No. 4,538,556, Takeda (“Takeda”) in view of U.S. Patent No. 6,517,595, Kino et al. (“Kino”). Claim 1 has been amended to incorporate a portion of claim 2, and claim 2 has been amended to omit the wording incorporated into claim 1. The rejection is respectfully traversed for reasons including the following, which are provided by way of example.

Claim 1 recites, in combination, for example “an air intake duct ...; an air cleaner ..., the air cleaner including a casing;...an air-permeable member disposed to block a communicating path disposed in a wall ...; and a valve, ... wherein the valve and the air-permeable member are disposed in the casing.” Claim 7 recites, in combination, for example, “a communicating path disposed in the air intake passageway, the communicating path further being disposed where there is an antinode of the lower resonance mode inside the air cleaner.”

The office action continues to assert that the combination of Takeda and Kino teaches the claimed invention. In particular, the final office action alleges that Takeda discloses “a valve 7 disposed in the wall for opening the communicating path to allow the inside of the intake air passageway to communicate with the outside thereof at least when the lower resonance mode occurs” (page 3). Original claim 2 (reciting that “the air cleaner includes a casing ...; and the

valve and the air permeable member are disposed in the casing”) is apparently encompassed by this allegation.

The applicants provide herein a selection of some examples of limitations in the claims which are neither taught nor suggested by Takeda. The final Office Action admits that Takeda “does not employ an air permeable member.” (Final Office Action, page 3.) Recognizing that Takeda fails to teach and/or suggest the invention as claimed, Kino is cited to remedy the deficiencies.

Nevertheless, Kino fails to remedy such deficiencies. For example, Takeda, Fig. 1, clearly illustrates the valve 7 disposed on the resonator 2. Takeda therefore fails to teach or suggest the valve disposed on the air cleaner 1, or the communicating path disposed inside the air cleaner 1.

Kino, on the other hand, illustrates an intake duct for introducing outside air into an air cleaner, and has a non-woven fabric closure fixedly bonded to cover an opening 13 formed in the intake duct. (Col. 3, lines 22 – 24.) Kino fails to disclose anything particular about an air cleaner. Therefore, Kino’s intake duct fails to teach or suggest a valve disposed in a casing of the air cleaner, or a communicating path disposed inside the air cleaner.

Hence, Takeda and Kino, alone or in combination, fail to teach or suggest the combination of features recited in independent claim 1, when considered as a whole.

Furthermore, neither the first nor final office action has provided a motivation to modify the combination of Takeda and Kino so that the valve and air-permeable member are disposed in the air cleaner, or the casing of the air cleaner. To the contrary, the office action assumes that placement of the valve (and apparently the communicating path) is inherent anywhere that there might be an antinode of a lower resonance mode. The contention that the placement of the valve

(or communicating path) and air permeable member anywhere there might be an antinode is respectfully traversed. That something may occur or be present in the prior art, which applicants vigorously deny, is insufficient to establish inherency. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.’” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). In order to support a contention of inherency, the allegedly inherent characteristic must necessarily flow from the teachings of the reference. *In re Levy*, 17 USPQ2d 1461, 1464 (Bd Pat. App. & Inter. 1990). None of the references of record show that the valve and air-permeable member must necessarily be disposed on the casing of the air cleaner. In fact, Takeda shows a contrary placement of the valve – in the resonator 2. Because the placement of the valve and air-permeable member is not inherent, the Examiner is respectfully requested to provide a citation to a reference or an Examiner’s affidavit, or to withdraw the rejection. 37 CFR 1.104(d)(2); MPEP 2144.03.

The office action also argues that the placement of the air-permeable member would be an obvious design choice, “as evidenced by claims 8 and 9 claiming it both ways.” However, “The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant’s specification, to make the necessary changes in the reference device.” *In re Chicago Rawhide Mfg. Co.*, 223 USPQ. 351, 353 (Bd. Pat. App. & Inter. 1984). Because there is no motivation for modification, other than the specification, the argument is unavailing.

In addition, the only motivation provided in the office action is to modify Takeda to include Kino's air permeable member to reduce noise levels. The motivation cited in the office action completely fails to provide any motivation to place the valve and air-permeable member in the casing of the air cleaner, or to dispose the communicating path inside the air cleaner.

With respect to the rejected dependent claims, applicants respectfully submit that these claims are allowable not only by virtue of their dependency from independent claims 1 and 7, but also because of additional features they recite in combination.

Applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicants do not concede that the cited prior art shows any of the elements recited in the claims. However, applicants have provided specific examples of elements in the claims that are clearly not present in the cited prior art.

Applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples applicants have described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, for the sake of simplicity, applicants have provided examples of why the claims described above are distinguishable over the cited prior art.

The applicants respectfully request entry of the present amendment for the following reasons. First, the amendments to the claims are necessary to address claim objections, or to incorporate features from claim 2 into claim 1.

Second, the amendments to the claims do not raise new issues requiring further search since the amendments involve incorporating features already existing in other pending claims.

Third, the applicants respectfully submit that no new matter has been introduced. In addition, the amendments made to the claims are minor changes performed in response to the Examiner's comments.

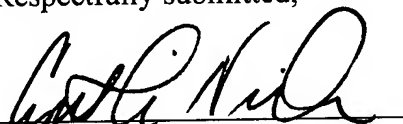
Finally, the amendments to the claims place the application in better form for appeal by materially simplifying the issues, i.e., correcting formality requirements and clarifying the asserted patentable distinctions over the prior art.

Accordingly, the applicants respectfully request entry of the present Amendment.

In view of the foregoing, the applicants respectfully submit that this application is in condition for allowance. A timely notice to that effect is respectfully requested. If questions relating to patentability remain, the examiner is invited to contact the undersigned by telephone.

Please charge any unforeseen fees that may be due to Deposit Account No. 50-1147.

Respectfully submitted,


Cynthia K. Nicholson
Reg. No. 36,880

Posz Law Group, PLC
12040 South Lakes Drive, Suite 101
Reston, VA 20191
Phone 703-707-9110
Fax 703-707-9112
Customer No. 23400